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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,495	04/09/2004	James M. Dennison	24122/1	1412
7590	06/01/2006		EXAMINER	
Joseph P. Quinn, Esq. Brown Rudnick Berlack Israels LLP One Financial Center, Box IP Boston, MA 02111			STASHICK, ANTHONY D	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 06/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/821,495	DENNISON, JAMES M.
Examiner	Art Unit	
Anthony Stashick	3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 1-20 is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 06 July 2004 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. ____.
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>11222004</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: ____.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Tecchio et al. 5,456,027.

Tecchio et al. '027 discloses all the limitations of the claims including the following: a shoe sole 110 having a first sole element 120; a second sole element 140; the first sole element associated with the second sole element such that when a threshold force is applied to one of the first or second sole elements, the threshold force causes the first and second sole elements to translate longitudinally relative to each other (see Abstract and col. 20, line 16-col. 21, line 48); an athletic shoe with a body portion 20; an upper sole element 120 permanently attached to the body portion; a lower sole element 140 releasably attached to the upper sole element such that a lateral relative motion between the upper sole element and the lower sole element is prevented and longitudinal motion between the upper and lower sole elements is resisted up to a predetermined release force (see Abstract and col. 20, line 16-col. 21, line 48).

3. Claims 1-4, 12, 15-16, and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Ouellette et al. 5,644,857. Oullette et al. '857 discloses all the limitations of the claims including the following: a shoe sole comprising a first sole element 14; a second sole element 16; the first sole element is associated with the second sole element such that when a threshold force is applied to one of the first sole element and the second sole element, the threshold forces causes the first sole element and the second sole element to translate longitudinally relative to each other (note portions 42 and associated portions 45 as well as 28 and associated portions 30, they will translate at a predetermined, i.e. known, force); an athletic shoe comprising a body portion 12; an upper sole element 16 substantially permanently attached

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to the body portion (see Figure 2); a lower sole element 14 releasably attached to the upper sole element such that lateral relative motion between the upper sole element and the lower sole element is prevented and longitudinal motion between the upper sole element and lower sole element is resisted up to a predetermined release force (note portions 42 and associated portions 44 as well as 28 and associated portions 30, they will translate at a predetermined, i.e. known, force); an upper sole 16 having a bottom surface 21 including a first longitudinal guiding element 42, 30; a lower sole 14 having a top surface 25 including a second longitudinal guiding element 44, 28; the second longitudinal guiding element engaging the first longitudinal guiding element and constraining the upper sole to longitudinal motion relative to the lower sole upon exertion of a threshold longitudinal shear force therebetween (see col. 4, lines 45-64 and col. 5, lines 29-53); the longitudinal guiding elements comprise a rail 44 and slot 42; a ligament portion 36 connected between the upper sole and lower sole and preventing longitudinal translation between the upper sole and lower sole unless a force exceeding a predetermined shear force is exerted therebetween; an upper sole 16 having a bottom surface 21 including a first longitudinal guiding portion 42; a lower sole 14 having a top surface 25 including a second longitudinal guiding portion 44 adapted for accepting said first longitudinal guiding portion and constraining said upper sole to longitudinal motion relative to the lower sole upon exertion of a threshold longitudinal shear force therebetween; a shear 36, 24 pin extending between said upper sole and said lower sole; cleats 18 extending downward from said lower sole; means for preventing translation between the upper sole and the bottom sole 36, 24; the shear pins are replaceable (new ones can be added); the longitudinal guiding portions comprise a rail 44 and slot 42.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 5-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ouellette et al. 5,644,857 as applied to claim 3 above in view of Starks 1,831,268. Ouellette et al. '857 as applied to claim 3 above discloses all the limitations of the claims including the breakaway portion comprising a shear pin 36, 24; the breakaway portion comprising a controlled friction portion (between 44 and 42); the controlled friction portion comprises a plurality of teeth 45 and the shear pin being formed integrally with the lower sole (see Figure 2). Ouellette et al. '857 does not disclose the breakaway portion extending through the longitudinal guiding elements. Starks '268 teaches that pins 12 can be placed through apertures 10 in the guiding elements 20, 8 to aid in holding the bottom sole to the top sole for use. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to place pins, such as those taught by Starks '268, in the guiding rails and slots of Ouellette et al. '857 to aid in holding the two soles together until the breaking force has been met.

6. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being obvious over the references as applied to claim 5 immediately above. The references as applied to claim 5 immediately above disclose all the limitations of the claims except for the breakaway portions being spot welds or adhesive. Spot welds and adhesive are well known art accepted equivalent means for pins used for fastening soles together. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to use any known means of fastening sole together, including spot welds, pins, screws, adhesives, to aid in holding the soles of the shoe together during use while still allowing for the breakaway feature to operate at a given minimum applied force.

7. Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 5 above in view of Tecchio et al. 5,456,027. The references as applied to claim 5 above disclose all the limitations of the claims except for the ligament portion being a spring or elastic

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band. Tecchio et al. '027 teaches that a ligament portion, that portion which attaches one sole to the other, can be attached by a spring loaded mechanism which disengages one sole from the other. The spring in this mechanism meets the limitation of a spring as a ligament portion because it is what aids in connecting the two sole portions together and releasing them. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the ligament portions of the references as applied to claim 5 above out of a spring to allow for displacement of the soles from one another but not total detachment of the soles from one another so as not to lose the bottom sole when detached. With respect to the ligament being a strap, it appears that a strap, lace or any other stretchable or extendible connection means would work equally as well as the spring noted above.

8. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oullette et al. 5,644,857 as applied to claim 16 in paragraph 3 above. Oullette et al. '857 as applied to claim 16 in paragraph 3 above discloses all the limitations of the claim except for the cleat including a shear pin extending upward through the upper and lower sole elements. Figure 12 of Oullette et al. '857 gives the appearance that the shear pin 24 is aligned with and part of the cleat 18 and therefore teaches that the pin can be associated with the cleat with the pin extending through the upper and lower sole portions. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the shear pin part of the cleat, as alluded to in Figure 12 of Oullette et al. '857, to allow for the shear pin to be easily replaced as the cleat is replaced.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure are cited on form 892 enclosed herewith.

Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111, including: "The reply must present arguments pointing out the specific distinctions believed to

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render the claims, including any newly presented claims, patentable over any applied references. A general allegation that the claims "define a patentable invention" without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section. Moreover, "The prompt development of a clear Issue requires that the replies of the applicant meet the objections to and rejections of the claims." Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06 II(A), MPEP 2163.06 and MPEP 714.02. The "disclosure" includes the claims, the specification and the drawings.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Stashick whose telephone number is 571-272-4561. The examiner can normally be reached on Monday through Thursday from 8:30 am until 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANDA) or 571-272-1000.

ADS



Anthony Stashick  
Primary Examiner  
Art Unit 3728